

REMARKS

Review and reconsideration on the merits are requested.

Formalities

Applicants appreciate the Examiner acknowledging receipt of copies of the certified copies of the priority document (there is one priority document) from the International Bureau and returning PTO/SB/08 (noting that one is a duplicate).

Detailed Action

Claim Objections

Claims 5-9 are canceled, mooted the claim objections.

Withdrawal is requested.

Claim Rejections - 35 U.S.C. § 101

The rejection of claims 11 and 23 is mooted by canceling these claims.

Claim Rejections - 35 U.S.C. § 112

Under the First Paragraph of § 112

Claims 5, 10-11, 13 and 22-23 are rejected under 35 U.S.C. § 112, first paragraph, the Examiner stating that though “the specification, while being enabling for inhibiting SGLT; treating diabetes, hyperglycemia, and disorders arising from hyperglycemia, does not reasonably provide enablement for preventing a disease associated with SGLT.”

Noting that certain of the above claims are canceled, any of the remaining claims which contain “prevention” or language are amended by deleting “prevention or”.

Withdrawal is requested.

Under the Second Paragraph of § 112

Claims 1-23 are rejected under the above section as being indefinite, as now explained.

With respect to claim 1, the Examiner finds the language “with the proviso that R⁴ represents” to be unclear.

If the Examiner will refer to page 6, line 18 to page 7, line 9 of the specification, it can be seen that the phrase “with the proviso that” means that compounds wherein X¹ to X⁴ have the meaning specified therein **and** R has the meaning specified therein, these are excluded from the compounds covered in claim 1.

Applicants appropriately amend claim 1.

If the Examiner thinks that the following language would be better, the Examiner is requested to contact the undersigned:

and with the proviso that when ---; X² represents N or CR² (~~with the proviso that wherein~~ R² represents ---); and when X⁴ represents N or CR⁴ (~~with the proviso that wherein~~ R⁴ represents ---), R represents --- --;

With respect to the rejection of claims 11 and 23 as improper “use” claims, these claims are canceled.

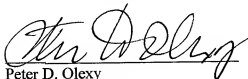
Withdrawal is requested.

In line with the language used by the Examiner at page 3, the first lines under **Claim Rejections - 35 U.S.C. § 112**, Applicants add claims 24-28.

In view of the above, reconsideration and allowance of this application are now believed to be in order, and such actions are hereby solicited. If any points remain in issue which the Examiner feels may be best resolved through a personal or telephone interview, the Examiner is kindly requested to contact the undersigned at the telephone number listed below.

The USPTO is directed and authorized to charge all required fees, except for the Issue Fee and the Publication Fee, to Deposit Account No. 19-4880. Please also credit any overpayments to said Deposit Account.

Respectfully submitted,

A handwritten signature in dark ink, appearing to read "Peter D. Olexy", written over a horizontal line.

Peter D. Olexy
Registration No. 24,513

SUGHRUE MION, PLLC
Telephone: (202) 293-7060
Facsimile: (202) 293-7860

WASHINGTON OFFICE

23373

CUSTOMER NUMBER

Date: September 30, 2008